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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,237	09/26/2001	David Ringshaw	PC9472B	9382

7590

12/17/2002

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EXAMINER

OWENS JR, HOWARD V

ART UNIT

PAPER NUMBER

1623

DATE MAILED: 12/17/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/963,237

Applicant(s)

RINGSHAW ET AL.

Examiner

Howard V Owens

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Detailed Action

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-5 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms "organic radical" in the absence of some chemical name or structural formula or art recognized functional description, are seen as indefinite terms. The examiner notes, the specification does not provide a standard to indicate the identity of those "organic radicals" applicants intend as part of the compositions claimed and one of skill in the art would not be reasonably apprised of the metes and bounds of the invention.

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35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loftsson, U.S. 5,472,954 in combination with Asato et al. (Asato), U.S. 4,886,829.

Claims 1-5 are drawn to a composition comprising at least one anthelmintically active compound which is an avermectin, milbemyacin or compound of formula I complexed with at least one cyclodextrin.

Asato teaches the compound of formula I and also teaches that compounds of this formula are antihelmintic compounds which may be formulated in liquid or solid form for infestation in warm blooded animals and agriculture. However, Asato does not teach the combination of the antihelminthic compound with cyclodextrin.

Loftsson bridges the nexus for the use of cyclodextrin with antihelmintic compounds as it teaches that antihelmintic compounds—such as ivermectin, avermectin, and milbemyacin--can complex with cyclodextrin (See column 8, lines 49 - 50) and that cyclodextrins have been used in the art to increase the stability of drugs and agrochemicals when complexed therewith (col.1-col.2). Loftsson also teaches that "solid pharmaceutical preparations, made, for example by removal of water from the above mentioned aqueous cyclodextrin polymer drug solutions, for example by lyophilization, are characterized by faster and more efficient dissolution of drugs compared to the dissolution of drugs from solid cyclodextrin preparations without polymers. This can lead to hastening the onset of the therapeutic response and can also increase the total bioavailability of drugs from solid pharmaceutical preparations (col. 15, lines 43-51)." Loftsson does not specifically teach the use of the compound of formula I with a cyclodextrin, however.

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It would have been *prima facie* obvious to the person of ordinary skill in the art at the time of the invention to have complexed a cyclodextrin with an antihelmintic.

One of skill in the art would have been motivated to combine an antihelminthic with a cyclodextrin for the purpose of obtaining a complex with improved water solubility over the uncomplexed drug while maintaining the biological activity of said drug.

Howard V. Owens
Patent Examiner
Art Unit 1623

A handwritten signature in black ink, appearing to read 'James O. Wilson', is written over a horizontal line. The signature is stylized with large loops and a long horizontal stroke extending to the right.

James O. Wilson
Supervisory Patent Examiner
Technology Center 1600

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Howard Owens whose telephone number is (703) 306-4538 . The examiner can normally be reached on Mon.-Fri. from 8:30 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the Supervisory Patent Examiner signing this action, James O. Wilson can be reached on (703) 308-4624 . The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.